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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,058	11/29/2000	Benjamin N. Truelove	MICR0519	8668
27792	7590	12/14/2005	EXAMINER	
RONALD M. ANDERSON MICROSOFT CORPORATION 600 108TH AVENUE N.E., SUITE 507 BELLEVUE, WA 98004			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/726,058	Applicant(s) TRUELOVE ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Action Background

1. This action is responsive to the applicant's amendment, filed on 9/26/2005.
2. Applicant has amended claims 1, 8, 11-13, 18 and 20-22.
3. Claims 1-23 are pending in the case, claims 1, 13 and 22 are independent claims.
4. Examiner's rejection of claims 1-23, made under 35 USC 112 in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 6/8/2005) is withdrawn in view applicant's remarks.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

6. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The terms "*portion of document text*" and "*immediately adjacent*" in claims 1, 13 and 22 are relative terms, which renders the claims indefinite. The terms "*portion of document text*" and "*immediately adjacent*" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

9. Claims 1-23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Russo Borland, "Running Microsoft Word 97", Published by Microsoft Press, Redmond, Washington USA, 1997. "*Russo Borland*" (herein after "*Borland*") in view of Parker et al. US Patent RE 36,704, filed 11/16/1995, patented 5/16/2000 (herein after "*Parker*").

10. **Regarding independent claim 1**, Borland discloses determining a sample of formats comprising a plurality of formats form a format set, where the format set includes a font set and a color set. Borland discloses the use of format "Styles" in the figure on page 60. The figure discloses a plurality of format styles and related samples. Each style has font and color settings; see Figure 2-5 on page 43 for examples of color and font settings related to styles. Borland discloses identifying a portion of text to be reformatted. Borland recites: "*To simply have Word apply a format to your document quickly after you're done adding text, set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)*"

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(page 37, second paragraph). Borland discloses reformatting the text and displaying the result in a live preview window. Borland discloses reformatted text in a preview window in the figure on page 61.

Borland discloses the live preview text being constrained to a portion of text disposed immediately adjacent to a cursor position in a document in the figure on page 51, in the Preview window shown at the bottom of the dialog box. Although not shown in this example, the cursor had been previously placed immediately adjacent to the "Wild Ride" text of the example document, which has caused the live preview to be constrained to that portion of document text.

Borland fails to disclose simultaneously displaying each of the reformatted text portions in live preview windows in order that a user can visually compare how each portion of text will appear in each of the formats. Parker teaches the simultaneous display of text portions for comparison by a user in Figure 6a at reference sign 610 (shown on the right hand side of the figure as four simultaneously displayed previews).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to combine the reformatting of Borland with the simultaneous display taught by Parker in order to "*produce user documents with a user selected typeface in a user selected format*" (Parker, column 1, lines 16-17).

11. **In regard to dependent claim 2**, the claim is directed toward a computer readable medium with computer executable instructions. Borland discloses

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reformatting documents as described above. Borland fails to explicitly describe a computer readable medium with instructions, but Borland describes common computer environment capabilities, like saving files (page 132), creating folders (page 133) and exiting applications (page 150).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to use the teachings of Borland on a computer system, because document format management is typically implemented on a computer system to allow instantaneous document reformatting capabilities.

12. **In regard to dependent claim 3**, Borland discloses selecting a color and font that determines a format set in the first figure on page 43. The user would select the "Ok" button in the dialog window shown in the first figure on page 43 to determine the selected format set.

13. **In regard to dependent claims 4 and 5**, Borland discloses a trained designer defining color schemes (claim 4) and font themes (claim 5). Borland discloses a "*Hiring a Decorator: AutoFormat*" section of his manual, starting on page 35 (second paragraph). Borland also recites: "*Improving the looks of characters means adding decorative touches to the basic appearance of words—selecting the font name, style, size, and colors*" (page 42, second paragraph).

14. **In regard to dependent claim 6**, Borland discloses a format having a font name, font color and font size in the first figure on page 43.

15. **In regard to dependent claim 7**, Borland discloses a preview window displayed above the document. Borland discloses a preview window dialog box in the figure on page 61. Window's Dialog boxes are displayed above the parent application (in this case the Word document).
16. **In regard to dependent claim 8**, Borland discloses receiving a command to add a custom format in the figure on page 60 (see the "New" button shown in the figure). Borland discloses adding the custom format to the sample of formats. Borland describes the steps to add a custom format (described as "Styles") on pages 826 to 842. Specifically the dialog box on page 830 (the upper figure on the page) shows the basic custom font-specifying tool, where the user would select the "OK" button to add the custom format to the sample of formats. Borland discloses reformatting the live preview text with the custom format and displaying the reformatted live preview text in the live preview window. Borland discloses a custom format (shown as "Invite") used to reformat a section of live preview text, which is displayed in a live preview window in the figure on page 834.
17. **In regard to dependent claim 9**, Borland discloses a user defined custom format. Borland describes the steps for a user to add a custom format (described as "Styles") on pages 826 to 842.
18. **In regard to dependent claim 10**, the claim contains substantially the same subject matter as claim 2, and is rejected with the same rationale.

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19. **In regard to dependent claims 11 and 12**, Borland discloses identifying the portion of text to be reformatted (claim 11) by text that has been highlighted (claim 12). Borland recites: *"To simply have Word apply a format to your document quickly after you're done adding text, set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)"* (page 37, second paragraph).
20. **In regard to independent claim 13**, the claim is directed to a system for performing the method of claims 1 and 3 combined, and is rejected with the same rationale.
21. **In regard to dependent claim 14**, the claim is directed to a system for performing the method of claim 6, and is rejected with the same rationale.
22. **In regard to dependent claim 15**, the claim is directed to a system for performing the method of claim 4, and is rejected with the same rationale.
23. **In regard to dependent claim 16**, the claim is directed to a system for performing the method of claim 5, and is rejected with the same rationale.
24. **In regard to dependent claim 17**, the claim is directed to a system for performing the method of claim 7, and is rejected with the same rationale.
25. **In regard to dependent claim 18**, the claim is directed to a system for performing the method of claim 8, and is rejected with the same rationale.

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26. **In regard to dependent claim 19**, the claim is directed to a system for performing the method of claim 9, and is rejected with the same rationale.
27. **In regard to dependent claim 20**, the claim is directed to a system for performing the method of claim 11, and is rejected with the same rationale.
28. **In regard to dependent claim 21**, the claim is directed to a system for performing the method of claim 12, and is rejected with the same rationale.
29. **In regard to independent claim 22**, the claim is directed to a user interface for performing the method of claims 1 and 3 combined, and is rejected with the same rationale.
30. **In regard to dependent claim 23**, the claim is directed to a user interface for performing the method of claim 8, and is rejected with the same rationale.

Response to Arguments

31. Applicant's arguments filed 9/26/2005 have been fully considered but they are not persuasive.
32. The examiner wishes to thank applicant for the information provided in the remarks section of the response filed 9/26/2005, which identified support for amended subject matter of the previous amendments. The related 35 USC 112 rejections are withdrawn as described above. However, new 35 USC 112 rejections have been made related to relative terms that render the claims indefinite. See this rejection as stated above.
33. **Regarding independent claims 1, 13 and 22**, applicant argues that: *"Borland never specifically teaches or suggests "simultaneously displaying live preview text reformatted in each of the formats in the sample of formats in a live preview window" where the live preview text is "constrained to the portion of document text disposed immediately adjacent to a cursor position in a document"* (page 8 last paragraph, to page 9 first paragraph of the response filed 9/26/2005). In response to these arguments the applicant is directed to the rejection of claim 1 as stated above. Borland discloses the live preview text being constrained to a portion of text disposed immediately adjacent to a cursor position in a document in the figure on page 51, in the Preview window shown at the bottom of the dialog box. Although not shown in this example, the cursor had been previously placed immediately adjacent to

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the "Wild Ride" text of the example document, which has caused the live preview to be constrained to that portion of document text.

34. Applicant's additional arguments are directed toward the "*constrained to the portion of document text disposed immediately adjacent to a cursor position in a document*" limitation of claims 1, 13 and 22. Applicant is directed to the examiner's response as described in the previous paragraph

Conclusion

35. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
December 8, 2005

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER

12/12/2005